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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/079,873	02/22/2002	Hiromitsu Tanaka	219871US0	7887

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EXAMINER

LE, HOA VAN

ART UNIT

PAPER NUMBER

1752

DATE MAILED: 08/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/079,873

Applicant(s)

TANAKA ET AL.

Examiner

Hoa V. Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 May 2004 and 22 July 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) 21-36 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 with 9-20 being permitted to be rejoined is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-36 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

This is in response to Elections filed on 24 May and 22 July 2004.

I. Applicant's election with traverse of the invention of Group I, claims 1-8 with claims 9-20 being permitted to be rejoined therewith in the reply filed on 24 May and 22 July 2004 is acknowledged. The traversal is on the ground(s) that (1) the restrictions are improper and (2) an additional search is not burdensome. This is not found persuasive because (*) it is contended that the restrictions are proper as clearly pointed out and set forth on the record with a suggestion that applicants are urged to show or provide an evidence to the contrary for the record and (**) an additional search is burdensome. Evidence can be seen that the elected process invention of Group I, especially see claim 1, is related, made, practiced and obtained with an electrolyte polymer having no side chain or terminal acid group, intermediate acid group or modified acid group. Applicants should show or provide a convincing evidence to the contrary. In the absence of convincing evidence to the contrary, the restriction would be removed.

The requirement is still deemed proper and is therefore made FINAL.

II. The elected species on the record have been considered and search. The consideration and search are extended to the applied species. Other non-elected species have not been considered, searched or examined until all of the elected and applied are overcome.

III. A. (1) It is allowed to claim by a functional, characteristic, conditional, physical and/or chemical property of a material and /or process. (2) However, a claimed functional,

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characteristic, conditional, physical and/or chemical property of a material and/or process carries with a risk (In re In re Schreiber, 44 USPQ2d 1432). It is reasonable that the Office is not supplied, provided or equipped with a sufficient facility to carry out a test for the functional, characteristic, conditional, physical and/or chemical properties as claimed in accordance with the authority stated in In re Best, 195 USPQ 430; Ex parte Maizel, 27 USPQ2d 1662 or Ex parte Phillip, 28 USPQ2d 1302. Please also see the related issue with respect no patentable sense as stated in In re Hutchison, 69 USPQ 138. The language “polymer electrolyte” or “polymer precursor” or the like is considered as a property of a material and is searched as appeared.

B. In re Schreiber, 44 USPQ2d 1429 states that “A patent applicant is free to recite features of an apparatus either structurally or functionally. See In re Swinehart... 169 USPQ 226, 228... Yet, choosing to define an element functionally, i.e., by what it does, carries with a risk. As our predecessor court state in Swinehart... where the Patent Office has reasons that the functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on.” A statement or argument alone may have and be given a little to no value because it is not factual evidence.

IV. Applicants' prior art submission filed on 22 February 2002 has been considered.

V. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 5 and 7 with independent claim 1 being broadest and respect to the applied species are rejected under 35 U.S.C. 103(a) as being unpatentable over Helmer-Metzmann et al (5,741,408) .

Helmer-Metzmann et al disclose, teach and suggest a process of treating an electrolyte polymer with an amine type containing compound. Please see the whole disclosure of applied reference, especially at col.4:35-54, electrolyte polymers (VII), (II) , (III), col.7:64-8 10:1, Examples 4 and 6. At the level of one skilled in the art, it is believed that Helmer-Metzmann et al is reasonably disclose, teach and suggest the claimed process at the time the invention was made. Should applicant disagree or urge otherwise, the law requires that applicants must show or provide a convincing evidence to the contrary to speed up the prosecution and to avoid any later work for an inherency of the claimed property and made or obtained product since a claim would has no value if someone later shows it to be known or used either together in one reference or a combined references. Law that applicant must show a convincing evidence to the contrary for his claimed property, process and made or obtained product as clearly pointed out and set forth in paragraph "III" since a statement or argument alone may has and be given a little value because it is not a factual evidence.

VI. Claims 1-8 with independent claim 1 being broadest and respect to the elected and applied species are rejected under 35 U.S.C. 103(a) as being unpatentable over Michot et al (6,670,424) .

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Michot et al disclose, teach and suggest a process of treating an electrolyte polymer with an amine type containing compound. Please see the whole disclosure of applied reference, especially at col.5:1-67 with "TEA" being triethylamine to one skilled in the art at col.5:37, Examples 2, 3, 5, 6, 9, 10, 11. At the level of one skilled in the art, it is believed that Michot et al is reasonably disclose, teach and suggest the claimed process at the time the invention was made. Should applicant disagree or urge otherwise, the law requires that applicants must show or provide a convincing evidence to the contrary to speed up the prosecution and to avoid any later work for an inherency of the claimed property and made or obtained product since a claim would has no value if someone later shows it to be known or used either together in one reference or a combined references. Law that applicant must show a convincing evidence to the contrary for his claimed property, process and made or obtained product as clearly pointed out and set forth in paragraph "III" since a statement or argument alone may has and be given a little value because it is not a factual evidence.

VII. Claims 1 and 6-8 with independent claim 1 being broadest and respect to the elected and applied species are provisionally rejected under 35 U.S.C. 103(a) as being unpatentable over Moya (Application Serial Nos. 10/089,217 or its division 10/848,399 which is equivalent to WO 01/27167 as submitted).

Moya discloses, teaches and suggests a process of treating an electrolyte polymer with an amine type containing compound. Please see the whole disclosure of applied reference WO...167 as submitted, especially at page 21, second paragraph from the bottom, page 29, last paragraph, Examples 1, 2 and 3, 5, 6, 9, 10, 11. At the level of one skilled in the art, it is

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believed that Moya is reasonably disclose, teach and suggest the claimed process at the time the invention was made. Should applicant disagree or urge otherwise, the law requires that applicants must show or provide a convincing evidence to the contrary to speed up the prosecution and to avoid any later work for an inherency of the claimed property and made or obtained product since a claim would has no value if someone later shows it to be known or used either together in one reference or a combined references. Law that applicant must show a convincing evidence to the contrary for his claimed property, process and made or obtained product as clearly pointed out and set forth in paragraph "III" since a statement or argument alone may has and be given a little value because it is not a factual evidence.

VIII. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoa V. Le whose telephone number is 571-272-1332.

The examiner can normally be reached from 6:30 AM to 4:00 PM on Monday though Thursday and about the same time of most Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelley can be reached on 571-272-1526.

Applicants may file a paper by (1) fax with a central facsimile receiving number 703-872-9306,

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hoa V. Le
Primary Examiner
Art Unit 1752

HVL
04 August 2004

HOA VAN LE
PRIMARY EXAMINER

Hoa Van Le